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mgIN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Kevin GATESMAN et al.

Conf. No.: 6166

Application No.: 09/294,475

Group Art Unit: 2665

Filed: April 20, 1999

Examiner: Nguyen, S.

Customer No.: 25537

Attorney Docket: 09710-1150

Client Docket: WMA 99 001

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For: COMMUNICATIONS CONTROLLER FOR PROVIDING MULTIPLE ACCESS USING
A SINGLE TELEPHONE LINE**REPLY BRIEF**Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted, in triplicate, in response to the Examiner's Answer mailed
June 25, 2004.

**I. THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* BASIS TO
REJECT CLAIMS 1-29 FOR OBVIOUSNESS.**

1. Claims 1-3, 6-7, 9-15, 17-18, and 20-29 are patentable over *Tönnby et al.* and *Itoi* because the references do not suggest a routing means "for selectively routing voice and data signals from said telephone and said computer to and from said circuit switched telephone network via said subscriber line based on said assigned internal network addresses."

In the Examiner's Answer (page 8), regarding item (1), the Examiner contends that *Tönnby et al.* at Fig. 7, Ref 80; col. 3: 4-8; col. 5: 9-19 and col. 9: 38-46 discloses "routing means" for receiving the voice and data signals from a subscriber line and "selectively routing the voice and data signals to its destination such as computer and telephone using Internet protocol," and then relies on *Itoi* as purportedly disclosing a communication device which comprises an address setting unit that assigns a unique internal address for each of a telephone and computer and establishes a routing table so that a routing means for selectively routing the incoming voice and data signals according to its internal addresses and external address at col. 3, lines 36-48 and col. 4, lines 24-30. The newly cited portion of *Tönnby et al.* (col. 5: 9-19) states the following:

As will be explained later the IP modem has multiplexor/demultiplexor functions that multiplexes information from different applications onto one and the same IP link to the IP gateway and that demultiplexes received information and forwards the demultiplexed information to their respective destinations. For example the IP modem will forward incoming IP packets from the Internet to an Internet application running on the PC 2 and will forward incoming packets containing speech information to the telephone 1 via a decoder, decompressor and a d/a converter. IP packets to and from the IP network will pass the IP gateway; they will not reach the telephony server.

The above passage merely refers to multiplexing functions and forwarding of IP packets from the Internet to the PC 2 as well as forwarding packets containing speech information to the telephone 1 **via a decoder, decompressor, and a D/A converter**. However, as Appellants pointed out in the Appeal Brief, referring to FIG. 8 of *Tönnby et al.*, the analog telephone 1 is not part of the LAN 61, and the portion of *Tönnby et al.* now cited by the Examiner (i.e., col. 5: 9-19) does not detract from Appellants' contention.

Further, there is absolutely no motivation to add an "internal network address" to a system that already has a capability of forwarding packets toward the telephone 1 via various components (e.g., decoder, decompressor, and a D/A converter). Even if one skilled in the art

were motivated at the time of the invention to modify *Tönnby et al.* in view of *Itoi*, that person of skill in the art, following the disclosure of *Itoi*, would only have been led to deploy the LAN switching apparatus **101** of *Itoi* to add analog telephones to the LAN **61** of *Tönnby et al.* Thus, the added analog telephones would ultimately be connected to IP modem **4** via PC/LAN interface **73/74**, and not to the non-LAN analog telephone interface **75**. It would make no sense therefore to assign an “internal **network** address” to the analog telephone **1**, as it would not be part of a system that requires an internal network address. Any addressing that needs to be performed for telephone **1** is already performed in the circuit switched telephone network. That is, the Examiner’s proposed modification to assign an internal network address has no technical merit.

To the extent that the Examiner chooses to focus only on the claim language of “address,” Appellants note that it is improper to ignore qualifiers in the claim terms such as “internal network” addresses. See *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14 (Fed. Cir. 2000) (holding that the district court “cannot read the qualifier ‘help’ out the definition of ‘help access window’” of claim 2).

2. **The combination of *Tönnby et al.* and *Itoi* fails to disclose “adapted to patch a call from the one telephone to the circuit switched network via the network interface means upon a determination that no data connection is established to the circuit switched telephone network.”**

The feature of “adapted to patch a call ...” reveals the technical inconsistencies with the Examiner’s reading of the *Tönnby et al.* and *Itoi* references. As Appellants pointed out in the Appeal Brief, referring to FIG. 8 of *Tönnby et al.*, the analog telephone **1** is not part of the LAN **61**. As discussed previously, even if one skilled in the art were motivated at the time of the invention to modify *Tönnby et al.* in view of *Itoi*, the added analog telephones would ultimately

be connected to IP modem 4 via PC/LAN interface 73/74, and not to the non-LAN analog telephone interface 75. The Examiner relies on the movable contacts 70 and 71 of *Tönnby et al.* as meeting the recited “patch a call” feature. However, the contacts 70 and 71 of *Tönnby et al.* provide a hard wired telephone connection, through the IP modem, between a telephone loop 57 including telephone 1, and a subscriber line when main power is down or when a manual switch is set for basic telephony. (col. 8: 56 - col. 9: 7) *Itoi* is concerned with “accommodating existent telephone sets and internet phone devices in a computer network such as a LAN.” (col. 1: 7-10) Thus, if some combination of *Tönnby et al.* and *Itoi* were to support the recited “internal network addresses,” the telephone 1 would be included in the LAN 61 of *Tönnby et al.*, and would be incapable of satisfying the “patch a call” feature. Thus, no reasonable combination of *Tönnby et al.* and *Itoi* suggests the language of “**adapted to patch a call from the one telephone to the circuit switched network**” as recited by claim 1.

Further, claim 1 recites “upon a determination that no data connection is established to the circuit switched telephone network.” Neither *Tönnby et al.* nor *Itoi*, nor any reasonable combination thereof, suggest any type of positive “determination” of whether a data connection is established to a circuit switched telephone network. As discussed previously, *Itoi* is not concerned with any circuit switched network. When *Tönnby et al.*’s movable contacts 70 and 71 are in contact with cable 72 (FIG. 6), a telephone connection is hard wired through the IP modem. However, this situation occurs only when main power is down or a user manually selects telephony mode, e.g., by flipping a switch. (col. 9: 1-7) At best, the *Tönnby et al.* switches involve only a hardware response to **lack of power**, or to a **manual switching by a user**, and not any type of “determination” of whether a “data connection” is established to a circuit switched telephone network as specifically recited at least by claim 1.

3. **The Examiner has not provided a reasonable motivation for combining Szeliga with Tönnby et al. and Itoi.**

Regarding the Examiner's items (4) and (13) (Examiner's Answer, pages 10-11), the Examiner contends that "it would have been obvious to one of ordinary skill in the art at the time of [sic] the invention was made to apply a universal indicator to a subscriber and a visual call waiting indicator as disclosed by Szeliga into the system of Tönnby and Itoi in order to provide an indicator to a deaf person." However, there is absolutely no mention anywhere in the applied references of any type of accommodations for incoming voice calls for a deaf person. For example, there is no disclosure in any of the references of how a deaf person would be engaged in a voice phone conversation, and would (or could) appreciate a visual call waiting indicator. Thus, this motivation provided by the Examiner is an improper attempt to establish some motivation stemming from the Examiner himself, rather than any suggestion provided by the references.

4. **The Examiner has raised nothing new in items (2), (3) and (5) - (12) of the Examiner's Answer.**

Regarding Examiner's items (2), (3) and (5) - (12), Appellants maintain that all of these points were already addressed in the Appeal Brief, and that the Examiner's Answer raises nothing new. Regarding item (6), Appellants respectfully submit that the Examiner states the correct standard for non-analogous art, but incorrectly applies the standard to two applied references instead of applying it to a reference and the inventor's field of endeavor or the problem with which the inventor was concerned. Appellants fully addressed the non-analogous nature of the applied references in the Appeal Brief.

II. CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG & CARLSON, P.C.

August 25, 2004
Date

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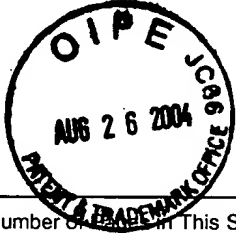
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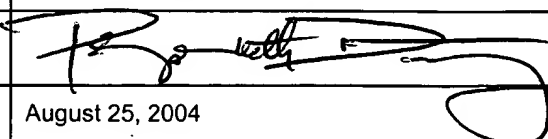
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	Filing Date	April 20, 1999	
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Total Number of Pages in This Submission	18	Client Docket Number	WMA 99 001

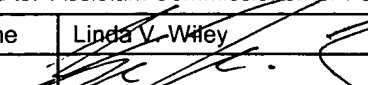
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